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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,301	01/17/2002	Chiu Ping Wong	54512US012	7122
32692	7590	01/23/2004	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY			CHANG, VICTOR S	
PO BOX 33427			ART UNIT	
ST. PAUL, MN 55133-3427			PAPER NUMBER	

1771

DATE MAILED: 01/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/053,301

Applicant(s)

WONG ET AL.

Examiner

Victor S Chang

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eb

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 47-76 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 47-76 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. The Examiner has carefully considered Applicants' amendments and remarks filed on 11/17/2003. Applicants' amendments to cancel claims 1-46 and add new claims 47-76 have been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn.

Specification

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: BIAXIALLY STRETCHED FILM.

5. The substitute specification filed 11/17/2003 has not been entered because it does not conform to 37 CFR 1.125(b) and (c): a marked-up copy of substitute specification has not been supplied.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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7. Claims 47-76 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 47, lines 2-3, also in claims 60 and 71, please rewrite the "stretch profile" in the form of "either ... or ...", so as to clarify the claim language.

In independent claims 47, 60 and 71, and throughout, the Examiner notes that the product-by-process recitations are erroneously recited as properties of the stretched film, and renders the claims vague, indefinite and confusing. The Examiner notes that while stretched film is generally characterized by its state of molecular orientation, the "stretch profile", "stretch parameter", etc., are conditions for stretching or processing, and are clearly not "properties" of a "stretched film". As such, a complete rewrite for most of the claims is required.

In claims 48, 50, 65 and 67, line 1, and throughout, the term "comprising" is clearly improper for a clause which does not recite any structural element. The Examiner suggests to change it to --having--.

For claim 53, line 1, the term "comprises" is clearly improper and does not conform to the current U.S. practice. The Examiner suggests to rewrite it in proper Markush format.

In addition, please correct any other informalities which may have been overlooked.

Response to Amendment

8. Claims 47-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blum et al. (US 4070523) in view of Applicants' admission, substantially for the reasons set forth in section 11 of Paper No. 0708, together with the following additional observations.

It is noted that Applicants have cancelled all the previously submitted claims, and added a new set of product-by-process claims 47-76. The Examiner notes that such an amendment appears to be non-responsive, because Applicants fail to point out any unobviousness of the new claims, which essentially have the same scope as the cancelled claims. Nevertheless, in the interest of expediting the prosecution, the newly added claims are examined as follows:

For newly added claims 47-76, the Examiner repeats (see Paper No. 0708, pages 4-5, bridging paragraph) that Blum's invention is directed to printable pressure sensitive adhesive tapes with a release coating on the opposite side (Abstract and Examples). Blum teaches that any backing material ordinarily used for this purpose may be used. The particular material chosen is dependent upon the end use for the pressure sensitive adhesive tape. The backing should have sufficient mechanical strength, humidity resistance, temperature insensitivity and other qualities, so as to be suitable for the particular purpose for which the tape was designed (column 10, lines 23-29). Examples of backing material include biaxially oriented (i.e., stretched) polypropylene (column 10, lines 31-37). As such, it is believed that an adhesive tape with a suitable biaxially oriented backing with suitable thickness and tensile properties

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(i.e., elongation to break and energy to break, etc.) is either inherently disclosed, or an obvious optimization to one of ordinary skill in the art, motivated by the desire to obtain desired mechanical strength, etc.

With respect to the product-by-process recitations in claims 47-76, the Examiner notes that Applicants appear to have admitted in the Specification, paragraph [0007], that prior art processes, while costly and slow, is able to continuously stretch films in both longitudinal and transverse directions, which is essentially the same process of the instantly claimed invention. Further, the Examiner repeats (see Paper No. 0708, page 5) that product-by-process claims are product claims and that to be limiting in a product claim, a process limitation must be evidenced as effecting the structure or chemistry of the resultant product over the prior art. Further, the burden of proof for this showing is on Applicant after the Examiner presents an otherwise *prima facie* rejection. Once a product appearing to be substantially identical is found and a 35 U.S.C. 102/103 rejection made, the burden shifts to the applicant to show an unobvious difference. Note MPEP 2113 for a more detailed description. Lastly, it should be noted that the cost of making bears no weight on patentability.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-0994.

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1300-
1700

Daniel Zinker